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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,729	02/08/2001	Keiji Minamida	P107312-00000	6892

7590

03/20/2003

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EXAMINER

BHAT, NINA NMN

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 03/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicant No.</b>	<b>Applicant(s)</b>	
	09/778,729	MINAMIDA, KEIJI	
	<b>Examiner</b>	<b>Art Unit</b>	
	N. Bhat	1761	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1-5 is/are allowed.
- 6) ☒ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-7 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C.

121:

- I. Claims 1-5, drawn to a method for producing water, classified in class 426, subclass 66.
- II. Claims 6-7, drawn to an apparatus, classified in class 220, subclass 377.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used for materially different processes for example the apparatus can be used in photometric or spectrometric testing and need not be used in the claims method of producing water.

3. During a telephone conversation with Mr. Oram on March 5, 2003 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Action on the merits of claims 1-5 follows:

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5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites "A method for producing water having absorbed wave motion energy peculiar to color, the method comprising the step of exposing an object having a color to sunrays so as to cause water to absorb wave motion energy peculiar to the color". First, there is a 112, second paragraph, which is, will be addressed in a separate paragraph using a different section of 112, where the claim is indefinite as there is no step where water is produced. The claim as drafted as well as the specification has not been described in such a way as to enable one skilled in the art to make and/or use the invention. Color originated in the discovery of the spectral nature of light by Newton in the 1600's. And that different colors result from casting white light on the prism. Color is light energy of different wavelengths and has a wavelength in the visible spectrum of 400-700 nanometers. Color therefore is light energy. When light strikes a surface there are two things, which can happen either refraction or reflection. Different colored items either absorbs light energy or scatters light energy. Light can be absorbed by colored materials according to a number of mechanisms that include atomic vibrations and rotations, ligand-field effects, molecular orbitals and charge transfer. The specific quantities of light energy are absorbed by a specific material and thus the light absorption properties of materials are wavelength selected. The energy that is absorbed by molecules can be dissipated as kinetic

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and heat energy but sometimes the energy can be re-emitted by fluorescence or phosphorescence. With these scientific principles which can be found in any physics book, applicant's claim reciting exposing an object having a color to sunrays to cause the water to absorb wave motion energy peculiar to the color is not enabled because the ordinary artisan would not be able to understand what is meant causing water to absorb wave motion energy peculiar to the color, without undue experimentation. The colored object in water is either going absorb light energy from the sun or scatter the energy from the sun's rays. The colored object as explained above, if absorbing energy will give off the energy from the sun probably by emanating heat. For example, if you have a dark colored object in the sun, the dark colored would absorb the energy from the sun and heat the water. It is unclear what applicant is trying to claim because there are colored things in water like boats, dingy's, floats, algae, aquatic plants etc. which are colored and would be exposed to sunrays and would cause water to absorb light wave energy, which would occur naturally in nature. From reading the specification and the claims, it is the opinion of the examiner that in order to practice the invention undue experimentation is needed utilizing the factors as described in *In re Wands*, 858 F.2d 731, 8 USPQ2d1400 (Fed. Cir. 1988). The specification does not show working examples nor that "wave motion energy" would be a foreign concept to most ordinary artisans there would be a very high unpredictability if one of ordinary skill in the art would try to make and or use the invention. It is maintained that when reading the specification and the claims as a whole applicant's specification is not enabled and there is not enough direction

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or guidance in the specification to one of ordinary skill in the art to make and or use the invention.

6. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1 it is unclear from the steps provided that the method would produce water. An object having a color is exposed to sunrays, so as to cause the water to absorb wave motion. There is no step and there is no step where water is produced. Water is already present. Further in claim 1 it is unclear what is meant by "wave motion energy peculiar to color"? There is no scientific basis for "wave motion energy peculiar to color". As explained above, color firstly is something which only a human mind can distinguish, and secondly with respect to color, the darker the color the more light will be absorbed the lighter the color the more the light will be scattered. In claim 4, having a color container exposed to sunlight via directly or via optical fibers again does not product water.

7. Because of the non-enablement issues, an art rejection is precluded.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Baldwin teaches a solar green house, wherein the plants being generally of a dark color and large surface area and transfers energy to humidified air. Boettcher teach a solar energy collector and water heater, the solar energy collector consists of a plastic sheet, which is dark in color. Smith teaches a solar energy absorbing device which is dark and color and thermally

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absorptive. Hsia teaches a floating solar heater for pool water, which includes a collector plate, which has a dark color to absorb solar energy efficiently.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Friday, 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



N. Bhat  
Primary Examiner  
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March 18, 2003

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